



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

NAI1P017/01.062.01

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on December 12, 2005

Signature

Typed or printed name Erica L. Farlow

Application Number

09/916,609

Filed

7/26/2001

First Named Inventor

W. McEwan

Art Unit

2193

Examiner

Ingberg, T.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 41,429☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Kevin J. Zilka

Typed or printed name

(408) 971-2573

Telephone number

12/2/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



REMARKS

The Examiner has rejected Claim 35 under 35 U.S.C. 112, second paragraph, as being incomplete. Specifically, the Examiner has stated that the omitted elements are: “compared for what?” In response, applicant emphasizes that “[i]n determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical.” In re Goffe, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976). In re Mayhew, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976).

Further, limiting an applicant to disclosed features in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, a rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality. See MPEP 2164.08(c). For example, in the present case, there is no discussion of elements deemed critical in the specification. Further, it should be noted that there are no such elements in the Abstract, as filed.

The Examiner has rejected Claims 1-21 and 27-35 under 35 U.S.C. 103(a) as being unpatentable over Norton AntiVirus Corporate Edition 7.0 released 1999 (Norton). Applicant respectfully disagrees with such rejection. With respect to each of the independent claims, the Examiner has relied on Norton’s LiveUpdate (page 8), Cures (page 9), and updates by email (page 12) to make a prior art showing of applicant’s claimed “executing the full-release scanner update on the computers for security scanning” and “executing the pre-release scanner update on the computers for testing purposes” (see this or similar, but not identical language in each of the independent claims).

Applicant respectfully asserts that Norton only teaches updates that include update definitions that are downloaded and installed on user computers for use in security scanning (see page 8). However, such updates are NOT pre-release scanner updates, as claimed by applicant, since they are only used for security scanning, and not for “testing purposes,” as claimed. In fact,

Norton expressly discloses that “[c]opies of infected items are forwarded from the Quarantine on the client machine to the centralized Quarantine..[and are then] submit[ted]...to SARC and...a virus definitions update [is received] by email [at the centralized Quarantine]” (see page 11). Furthermore, “[a]fter applying the update on the centralized Quarantine to test and confirm the update, the updates are rolled out to client machines” (page 11).

Thus, in Norton the updates are only tested at a central Quarantine before being distributed to client machines. Applicant, on the other hand, claims that “the pre-release scanner update [is executed] on the computers for testing purposes” (emphasis added). Such computers, as claimed by applicant, are the same computers as the full-release scanner update is executed on for security purposes. Thus, nowhere in the entire Norton reference is there any mention of pre-release scanner updates in the specific context claimed by applicant.

In the latest Office Action dated 10/19/2005, the Examiner has responded to applicant’s arguments by stating that Norton also discloses SARC, a center where viruses are tracked, identified and analyzed and new anti virus technology is developed (Norton page 8). Furthermore, the Examiner has noted that Quarantine tests and confirms new updates and the updates are rolled out to client machines (Norton page 12).

Applicant again respectfully asserts that Norton only teaches updates that include update definitions that are downloaded and installed on user computers for use in security scanning (see page 8), and not for testing purposes, in the manner claimed by applicant. Applicant emphasizes that Norton teaches that “a virus definitions update [is received] by email [at the centralized Quarantine]” (see page 11), and furthermore that “[a]fter applying the update on the centralized Quarantine to test and confirm the update, the updates are rolled out to client machines” (page 11-emphasis added).

Thus, in Norton, the updates are tested on the centralized Quarantine before being sent to client machines where the updates are then used in security scanning. Thus, Norton teaches the process as follows:

1. Receive virus definitions update by email at the centralized Quarantine (page 11).

2. Test virus definitions update at centralized Quarantine (page 12).
3. Roll updates out to client machines for security scanning (pages 8 and 12).

Applicant, on the other hand, claims “executing the full-release scanner update on the computers for security scanning” and “executing the pre-release scanner update on the computers for testing purposes” (see this or similar, but not identical language in each of the independent claims). In this way, the full-release scanner update for security scanning and the pre-release scanner update for testing purposes are both executed on the same claimed computers, whereas Norton completes the security scanning and the testing at different computers (i.e. the client machines and centralized Quarantine, respectively).

Still with respect to each of the independent claims, the Examiner has relied on the testing of the updates at a centralized Quarantine to make a prior art showing of applicant’s claimed “transmitting results of the testing from the computers to the server utilizing the network” (see this or similar, but not identical language in each of the independent claims). Applicant respectfully emphasizes that the testing and confirming of the updates in Norton is completed at the centralized Quarantine, and then the confirmed updates are distributed to client computers (see page 11, lines 1-2). Thus, in Norton the results of the testing must be transmitted from the centralized Quarantine where the testing is completed, and not “from the computers to the server utilizing the network,” as claimed by applicant (emphasis added).

In the latest Office Action dated 10/19/2005, the Examiner has again admitted that the “centralized Quarantine tests and confirms new updates” (page 12). However, applicant notes that nowhere in Norton is there any disclosure of “transmitting results of the testing,” as claimed by applicant. Furthermore, in Norton, the testing is performed at the centralized Quarantine before sending the update to the client computers. Thus, even if Norton did disclose transmitting results, the results would be transmitted from the centralized Quarantine where the testing was performed, and not “from the computers to the server,” as claimed by applicant.

In addition, the Examiner has relied on his rejection of Claim 1 to make a prior art showing of applicant’s claimed “utilizing the results to modify the pre-release scanner update before releasing the pre-release scanner update as a full-release scanner update” (see this or similar, but

not identical language in each of the independent claims). Applicant respectfully asserts that Norton only discloses that a centralized Quarantine tests and confirms an update before distributing it to client machines (see page 11). However, there is no teaching in Norton of utilizing the results of the testing “to modify the pre-release scanner update,” in the specific manner claimed by applicant (emphasis added). Again, a notice of allowance or a specific prior art showing of all of applicant’s claim limitations, in combination with the remaining claim elements, is respectfully requested.

In the latest Office Action dated 10/19/2005, the Examiner has relied on Norton’s disclosure that the centralized Quarantine tests and confirms new updates and the updates (Norton page 12) to make a prior art showing of applicant’s specific claim language. The Examiner has further stated that Norton tests bug fixes and based on the results updates before releasing pre-release scanner updates.

For substantially the same reasons as argued above, applicant again respectfully asserts that simply nowhere in Norton is there any disclosure of “results” in the context claimed by applicant. To emphasize, Norton only discloses that a centralized Quarantine tests and confirms an update before distributing it to client machines (see page 11). However, there is no teaching in Norton of utilizing the results of the testing “to modify the pre-release scanner update,” in the specific manner claimed by applicant (emphasis added).

Furthermore, since the centralized Quarantine tests and confirms the update before releasing it to client computers, such results simply could not meet applicant’s claimed results since applicant claims that the results are transmitted from the computers to the server, and not that they are merely provided and utilized by the centralized Quarantine, as the Examiner contends.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success

must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991). Applicant respectfully asserts that at least the third element of the prima facie case of obviousness has not been met since the prior art reference fails to teach or suggest all of the claim limitations, as noted above.

The Examiner's rejections are also deficient with respect to the dependent claims, since such rejections also do not meet each and every element of the prima facie case. For example, with respect to Claims 2 and 3, the Examiner has relied on Norton's LiveUpdate feature (page 8) to make a prior art showing of applicant's claimed techniques "wherein the full-release scanner update and the pre-release scanner update are distributed simultaneously" (Claim 2) and "wherein the full-release scanner update and the pre-release scanner update are distributed together" (Claim 3). However, applicant notes that such updates provided by LiveUpdate are only executed for security scanning. Since, Norton does not disclose distributing a pre-release scanner update executed for testing purposes, as argued with respect to the independent claims, Norton also does not disclose distributing simultaneously or together "the full-release scanner update and the pre-release scanner update," in the context claimed by applicant.

With respect to Claim 9, the Examiner has relied on Norton's disclosure of SARC (pages 8-9) to make a prior art showing of applicant's claimed technique "wherein the results are transmitted to a quality assurance administrator." However, only infected files are transmitted from a client's Quarantine to SARC. In view of this, it is clear that Norton does not teach any sort of pre-release testing "results [that are] transmitted to a quality assurance administrator," as claimed by applicant (emphasis added).

With respect to Claim 10, the Examiner has relied on Norton's disclosure of the development of new antivirus protection and the distribution of such updates (page 12) to make a prior art showing of applicant's claimed "comparing results of the execution of the full-release scanner update and the pre-release scanner update." Applicant respectfully asserts that simply creating and distributing updates where such updates are based on newly infected files, as in Norton, does not meet applicant's specific claim language, namely "comparing results of the execution of the full-release scanner update and the pre-release scanner update" (emphasis added).